

REMARKS/ARGUMENTS

It is noted that box number 10 pertaining to the drawings on the PTOL-326 Office Action Summary has not been checked. Accordingly, applicant will proceed on the assumption that the drawings are accepted by the Examiner.

Claims 1-12 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of commonly assigned U.S. Application Serial No. 10/861,984. Upon allowance of the instant application, a terminal disclaimer will be filed in Serial No. 10/861,984.

Claims 1-12 stand rejected under 35 USC 103 as unpatentable in view of the teachings of four U.S. Patents. Since claims 2-3 and 8 have been cancelled and no new claims have been added, this response will address the rejection of remaining claims 1, 4-7 and 9-12 only.

Claims 1, 4-7 and 10-11 stand rejected under 35 USC 103 as being unpatentable over U.S. Patent No. 6,602,704 in view of U.S. Patent No. 5,638,976, the Examiner reasoning that the '704 patent discloses all of the features claimed in those claims except for the locking means claimed by applicant, but that the '976 patent discloses a container with a locking lid with locking means "identical" to that claimed by applicant, and that therefore it would have been obvious to one skilled in the art to replace the '704 locking means with the '976 locking means. This rejection is respectfully traversed.

Before addressing the merits of this §103 obviousness rejection, applicant respectfully submits that it is doubtful as to whether the '976 patent can properly be regarded to be analogous art. Whether a reference comprises analogous art is a fact question decided by two criteria: (1) whether the art is within the same field of endeavor as the claimed invention; and (2) if the reference is not within the same field of endeavor, whether it still is reasonably pertinent to the particular problems with which the inventor is involved. *In re Oetiker*, 24 USPQ 2d 1443 (Fed Cir 1992). Here, the field of the invention of the '976 patent is garbage pails classified in Class 220, which field is certainly not the same field of the claimed invention, which is a contact plate for the culturing of microorganisms, classified in Class 435. Accordingly, the answer to question (1) above must be "no."

As to question (2), the problem addressed by the invention of the '976 patent is to fabricate a garbage pail and lid that resist distortion during use. See column 1, lines 5-33. In contradistinction, the purpose of the claimed invention is to provide a lock between a contact plate and a lid therefor that permits the contact plate to be lifted by its lid, and yet prevent premature locking engagement between the contact plate and lid during automated pre-loading of the contact plate with cell-culturing medium. See applicant's specification at page 4, lines 1-9 and 19-21. Note that there is no mention in '976 of the possibility of making the locking arrangement sufficiently strong to permit the garbage pail to be lifted by its lid or of preventing premature locking engagement while filling the garbage pail. Thus, because the invention of the '976 patent is directed to a different purpose than that of the claimed invention, one of ordinary skill in the art of contact plates would have little motivation to consider the subject matter of the '976 patent as being pertinent. See *In re Clay*, 23 USPQ 2d 1058 (Fed Cir 1992).

For the above reasons, the '976 patent is respectfully submitted not to be analogous art and so cannot be relied upon to support the §103 obviousness rejection.

Nevertheless, even assuming the '976 patent to be analogous art for purposes of argument, the §103 rejection based on a combination of the teachings of that patent with those of the '704 patent is submitted not to be well-founded for the reasons stated below.

Claim 1 has now been amended to recite that the sheath has a closed end distal to the entry of the sheath and that the protrusion(s) of the radial tab is proximal to the entry of the sheath and further that the indent(s) of the radial sheath is distal to the entry of the sheath. A careful reading of the '976 patent shows that none of these features are present in the garbage pail design of that patent. Although the Examiner contends that '976 discloses radial sheaths having a closed end 26, this is incorrect. Specifically, the '976 patent states that the passage 25 of lug 22 "tapers in a circumferential direction from a small cross section *opening* (26) and gradually widens... to a larger cross sectional opening (27)." Column 4, lines 25-27 (emphasis added). Thus, element 26 is not a closed end as claimed by applicant, but rather is an opening. Moreover, as seen in FIGS. 17-18 of the '976 patent, protrusions 122 on lug 22 are not proximal to the entry of passageway 25, but rather extend along the entirety of passageway 25, and indentations 112 are not distal to the entry of passageway 25, but rather are located along the entirety of rib 12, and so when rib 12 and lug 22 are engaged necessarily extend along the entirety of passageway 25. Accordingly, independent claim 1 as amended is submitted to be distinguishable from the combined teachings of the '704 and '976 patents. Since claims 4-7 and 10-11 all ultimately depend from claim 1 and so incorporate the same limitations as does claim

1, those claims are submitted to be distinguishable from the combination of the '704 and '976 patents as well.

The Examiner also deems the limitations of claims 5-7 pertaining to the sheath being integral with the base and the tab being integral with the top cylindrical side wall to be an obvious expedient of the arrangement in the '976 patent wherein rib 12 is integral with the sidewall of container 10 and lug 22 is integral with lid 20, contending that the claimed arrangement amounts to a mere reversal of parts. However, since claims 5-7 are dependent from claim 1, this point is submitted to be moot in view of claim 1 as amended and the points noted above.

Claim 9 stands rejected under 35 USC 103 as being unpatentable over the '704 patent in view of the '988 patent, the Examiner reasoning that '988 discloses a contact plate with a transparent base and cover and therefore it would have been obvious to make the base and cover of the contact plate of the '704 patent transparent. In response, applicant points out that claim 9 ultimately depends from claim 1. The Examiner has already conceded in the Office Action that claim 1 prior to amendment was distinguishable from the '704 primary reference by virtue of the claimed locking means. Since claim 9 is dependent from claim 1, it is necessarily distinguishable from the combination of the teachings of the '704 and '976 patents.

Finally, claim 12 stands rejected under 35 USC 103 as unpatentable over the '704 patent in view of the '676 patent, the Examiner reasoning that because the '676 patent discloses the desirability of providing a contact plate in a sterile condition by providing packaging, it would have been obvious to provide the '704 contact plate with sterile packaging. In response,

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applicant points out that claim 12 ultimately depends from claim 1; because claim 1 is admittedly distinguishable from the '704 patent by virtue of the claimed locking means, it is also necessarily distinguishable from the combination of teachings of the '704 and '976 patents.

For the reasons stated, early and favorable reconsideration is respectfully solicited.

Respectfully submitted,



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